



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Escobosa)	Examiner:	Shimizu, Matsuichiro
Serial No.	09/615,473)	Art Unit:	2635
Filed:	July 13, 2000)	Attny Docket:	81230.56US1
Title:	Customizable And)		
	Upgradable Devices And)		
	Methods Related Thereto)		

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's rejection of the claims set forth in the Office Action mailed September 25, 2006 in which prosecution of the subject application was reopened from a pending appeal.

This Appeal Brief is being filed in triplicate.

A further Notice of Appeal is being filed herewith.

It is not believed that any additional fees are due. Nevertheless, the Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of October, 2006.

By: _____

Ranni Matar
Ranni Matar

I. Real Party In Interest

The real party in interest is Universal Electronic Inc.

II. Related Appeals And Interferences

An appeal of the final rejection of the claims of commonly assigned, U.S. Application Serial No. 10/386,792, filed on March 12, 2003, is pending.

An appeal of the final rejection of the claims of commonly assigned, U.S. Application Serial No. 10/151,635, filed on May 20, 2002, is pending.

An appeal of the final rejection of the claims of commonly assigned, U.S. Application Serial No. 10/411,792, filed on April 11, 2003, is pending.

U.S. Application Serial No. 10/386,792, U.S. Application Serial No. 10/151,635, and U.S. Application Serial No. 10/411,792, all claim the benefit of the subject application for patent.

III. Status Of The Claims

In the application, claims 54-80 remain pending and, having been twice rejected, are the subject of this appeal. Of these claims, dependent claims 63, 67, 73, and 77, while objected to as being dependent upon a rejected base claim, have been deemed to contain allowable subject matter.

Claims 1-53 were canceled during the course of prosecution.

The attached Appendix provides a clean, double spaced copy of pending claims 54-80.

IV. Status Of Amendments

No amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

With reference, by way of example only, to page 15, lines 18+ and figs. 1, 4, and 5 of the subject application for patent, the invention recited in independent claims 54 and 71 is generally directed to a method of configuring a remote control to command functions of a consumer electronic device.

With respect to independent claim 54, this goal is achieved by receiving at a computer, e.g., Web site server (32), user input (42) that functions to identify a type and brand of a consumer electronic device and using at the computer (32) the input that identifies the type and brand of the consumer electronic device to select a plurality of command sets that have been identified as being candidates for commanding operations of the specified type and brand of the consumer electronic device. The plurality of command sets that have been identified as being candidates for commanding operations of the specified type and brand of the consumer electronic device are then downloaded from the computer (32) into a remote control (10/10a) whereby a user may determine by experimentation (49/49a) which of the plurality of command sets is appropriate for commanding operations of the consumer electronic device that is actually owned by the user.

With respect to independent claim 71, this goal is achieved by displaying at a Web site a list (44) comprising a plurality of types of consumer electronic device for allowing a user to select one of the plurality of types of consumer electronic device from the list to specify a type of a consumer electronic device and a list (46) comprising a plurality of brands of consumer electronic device for allowing the user to select one of the plurality of brands of consumer electronic device from the list to specify a brand of the consumer electronic device. The Web site then uses the user specified type of the consumer electronic device and the consumer

specified brand of the consumer electronic device to select a plurality of command sets that have been identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device and makes at least a subset of each of the plurality of selected command sets available whereby a user may determine by experimentation which one of the plurality of command sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device. In addition, the Web site displays to the user a key layout (22) for the remote control and a list of functions (66a) from the command sets determined to be appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device to allow the user to assign functions from the list of functions to the key layout with the key layout and function assignments additionally being downloadable from the Web site to the remote control (10/10a).

VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether the rejection of independent claim 54 (and its dependent claims) under 35 U.S.C. § 102 based upon Chiloyan (U.S. Patent No. 6,008,735) can be maintained when Chiloyan simply fails to disclose the exact invention that is expressly set forth in the claim at issue.

2. Whether the rejection of independent claim 71 (and its dependent claims) under 35 U.S.C. § 103 based upon the combination of Chiloyan and Kemink (WO/017738) can be maintained when the references, whether considered alone or in combination, fail to disclose each and every element that is expressly set forth in the claim at issue and fail to suggest their combination to arrive at the exact invention that is expressly set forth in the claim at issue.

3. Whether the rejection of dependent claims 65 and 75 under 35 U.S.C. § 103 based upon the combination of Kemink, Chiloyan, and Foster (U.S. Patent No. 6,211,870) can be maintained when Foster simply fails to have any disclosure that might be said to suggest modifying the other references to arrive at the exact invention that is expressly set forth in the claims at issue.

VII. Argument

A) Summary of the outstanding rejections of the claims

Independent claim 54 stands rejected under 35 U.S.C. § 102 as being anticipated by Chiloyan. In rejecting the claim it was asserted that, among other things, Chiloyan discloses (in col. 5, lines 25-29) receiving user input at a computer that functions to specify a type of a consumer electronic device, using the user input at the computer to select a plurality of function code sets that have been identified as being candidates for commanding operations of the specified type of the consumer electronic device, and causing at least a subset of each of the plurality of selected command codes sets to be downloaded from the computer into a remote control.

Independent claim 71 stands rejected under 35 U.S.C. § 103 as being rendered obvious by the combination of Chiloyan and Kemink. In rejecting the claim it was asserted that it would have been obvious to modify the system of Chiloyan using the teaching within Kemink of displaying at a Web site a list for purposes of searching a larger database “because such features without unnecessarily searching the limited database, thus searching the larger database.”

Dependent claims 65 and 75 stand rejected under 35 U.S.C. § 103 based upon the combination of Kemink, Chiloyan, and Foster. In rejecting the claims it was asserted that it

would have been obvious to modify the other references based upon the disclosure in Foster of assignments of function codes to a key layout for the purpose of providing volume control “because such features without unnecessarily searching for desired key layout, thus providing volume control.”

B) Applicable case law

It is respectfully submitted that a claim is anticipated under 35 U.S.C. § 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). To maintain a rejection under 35 U.S.C. § 102 “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that a rejection under 35 U.S.C. §103 requires that a combination of references disclose, either expressly or inherently, each and every element set forth in the claims, considering the claims “as a whole.” The requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. In other words, the test of

whether it would have been obvious to select specific teachings and combine them must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

C) Remarks addressing the rejection of independent claim 54

As discussed above, independent claim 54 stands rejected under 35 U.S.C. § 102 as being anticipated by Chiloyan.

In response to the rejection, it is acknowledged that col. 5, line 25-29 of Chiloyan relied upon in the rejection of the claims does describe downloading code sets from a computer to a remote control generally:

The remote control unit also includes a data link interface 24. The interface 24 can be connected to a computer 26 or other suitable device to allow data, such as additional code sets, to be downloaded from the computer 26 and stored in the memory 14 of the remote control unit.

(Col. 5, line 25-29 of Chiloyan).

However, it will be appreciated that this cited to passage from Chiloyan (as well as Chiloyan in its entirety) is completely silent as to the computer (26) receiving user input that specifies a type of a consumer electronic device whereupon the computer (26) functions *to select a plurality of function code sets that have been identified as being candidates for commanding operations of the type of the consumer electronic device specified by the user input* and causes at least a subset of each of the plurality of *the selected command codes sets* to be downloaded from the computer into a remote control. Accordingly, since it is evident that Chiloyan fails to disclose, teach, or suggest each and every element that is expressly set forth in independent claim 54, with Chiloyan instead describing nothing more than a method for transferring data generally to a remote control

without further qualification in a manner similar to, for example, U.S. Patent No. 4,959,810 discussed in the background section of the subject application for patent, it is respectfully submitted that the rejection of independent claim 54 must be withdrawn.

D) Remarks addressing the rejection of independent claim 71

As discussed above, independent claim 71 stands rejected under 35 U.S.C. § 103 as being rendered obvious by Chiloyan as modified by Kemink.

In response to this rejection, it is respectfully submitted that, as discussed above, Chiloyan fails to disclose, teach, or suggest a computer, that is capable of downloading data to a remote control, that receives user input that specifies a type of a consumer electronic device and which functions *to select a plurality of function code sets that have been identified as being candidates for commanding operations of the type of the consumer electronic device specified by the user input* whereby a user may use at least a subset of each of the plurality of *selected command codes sets* to determine which of the selected command code sets is appropriate for use in commanding functions of the consumer electronic device. It will thus be evident that, contrary to the position taken in the rejection of the claims, Chiloyan does not disclose all of the claimed subject matter excepting the use of a Web site list in the configuration process. Accordingly, it is respectfully submitted that the very foundation upon which the rejection is based is in error and, for at least this reason, the rejection of the claim must be withdrawn.

While Chiloyan discloses a remote control to which data may be downloaded generally and a remote control which provides a conventional remote control based step-and-set configuration process, Kemink describes a system in which a remote control *is configured immediately after a single command set* (which the configuring system of Kemink identifies as being appropriate for commanding a consumer electronic device as a function of a user specified

model number) is downloaded into the remote control. More particularly, the configuring system of Kemink uses a consumer electronic device specific profile to determine the single command set that is to be downloaded into the remote control to thereby configure the remote control to command that consumer electronic device. (See Page 6, lines 7-10). The consumer electronic device specific profile is created by a user being “led through a sequence of links and web pages until a manufacturer’s model number is found that corresponds, for example, to the television 251 in FIG. 2.” (See Page 6, lines 13-15). Thus, it will be appreciated that the system of Kemink uses a particular consumer electronic device model number that is required to be specified by the user to select and download to a remote control a single command set and, as such, suffers a disadvantage the claimed invention seeks to overcome.

Returning now to the rejection of the claims, it is respectfully submitted that, when Chiloyan and Kemink are fully and fairly considered in their entirety as is required, were one to use the teachings of Kemink to modify the system of Chiloyan as espoused in the rejection of the claims, the express teachings of Kemink negate any need to allow a user to determine by experimentation which one of a plurality of selected command code sets is appropriate for commanding operations of an appliance as is claimed. In this regard, there simply would be no reason for one of skill in the art to maintain the Chiloyan remote control based step-and-set configuration methodology when modifying the Chiloyan system according to the teachings of Kemink since, by the very teachings of Kemink, a remote control *will already be configured* to command operations of a given appliance upon the downloading of the single command set that is determined by the system of Kemink to be appropriate based upon the user-specified model number. Thus, it is respectfully submitted that the reconstruction of Chiloyan in view of Kemink advanced in the rejection of the claims is unduly speculative and reflective of the impermissible

use of hindsight reasoning, i.e., it is not evident how a person of ordinary skill in the art would have arrived at the exact invention claimed when the teachings of Chiloyan and Kemink are clearly in conflict. For this still further reason it is respectfully submitted that the rejection of the claim fails to present a *prima facie* case of obviousness and must be withdrawn.

While neither Chiloyan nor Kemink disclose, teach, or suggest the desirability of a computer system, that is capable of downloading data to a remote control, using a type and brand of a consumer electronic device to cause a *plurality of command sets to be identified as being appropriate for commanding functions of the specified type and brand of consumer electronic device* whereupon a user [and not the configuring system as in Kemink] determines which of the *identified plurality of command sets* is appropriate for commanding the consumer electronic device actually owned by the user, it is further respectfully submitted that nothing from Chiloyan nor Kemink discloses, teaches, or suggests the claimed use of the identified plurality of command sets to create on a Web site mapping assignments for a remote control key set. In this regard, it has not even been alleged in the rejection of claim 71 that Chiloyan or Kemink discloses, teaches, or suggests this additionally claimed element of claim 71. Thus, for this yet further reason it is respectfully submitted that the rejection of claim 71 must be withdrawn.

E) Remarks addressing the rejection of claim 65 and 75

With respect to claims 65 and 75, it is respectfully submitted that nothing from Foster describes, teaches, or suggests the claimed downloading of assignments of function codes to the key layout using a speaker in the downloading process. While in the passage relied upon in the rejection of the claims Foster may describe using vol+ and vol- keys to control the output of a speaker, this disclosure has nothing to do with subject matter claimed. Thus, Foster cannot suggest the modification espoused in the rejection of the claims and dependent claims 65 and 75

must be deemed to contain patentable subject matter.

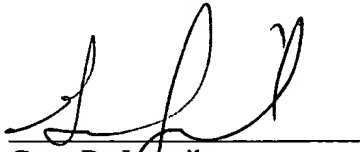
F) Conclusion

It is respectfully submitted that, when the claims are considered *as a whole*, the claims are not rendered obvious by the cited references. As such, it is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: October 4, 2006

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VIII. Claims Appendix

The following presents a clean copy of the claims that are the subject of appeal:

54. A method for selecting a command set for use in a remote control, comprising:

receiving user input at a computer that functions to specify a type of a consumer electronic device and a brand of the consumer electronic device;

using the user input at the computer to select a plurality of command sets that have been identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device; and

causing at least a subset of each of the plurality of selected command sets to be downloaded from the computer into the remote control whereby a user may interact with the remote control to determine by experimentation which one of the plurality of command sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.

55. The method as recited in claim 54, comprising displaying to the user a list comprising a plurality of types of consumer electronic device and the user selecting one of the plurality of types of consumer electronic device from the list comprises the user input that functions to specify the type of the consumer electronic device.

56. The method as recited in claim 54, comprising displaying to the user a list comprising a plurality of brands of consumer electronic device and the user selecting one of the plurality of brands of consumer electronic device from the list comprises the user input that functions to specify the brand of the consumer electronic device.

57. The method as recited in claim 54, wherein the subset of each of the plurality of command sets includes at least a code for commanding a power operation of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.

58. The method as recited in claim 54, comprising arranging the downloaded plurality of command sets such that the plurality of command sets will be tested in an order according to their install base when the user interacts with the remote control to determine by experimentation which one of the plurality of function code sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.

59. The method as recited in claim 54, comprising using the one of the plurality of command sets that is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device to identify an extended command set for use in commanding extended operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.

60. The method as recited in claim 54, wherein the user input is received at the computer via an Internet connection.

61. The method as recited in claim 54, wherein the plurality of command sets are downloaded from the computer directly into the remote control.

62. The method as recited in claim 54, comprising displaying to the user a key layout for the remote control and a list of functions from the command set appropriate for commanding

operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device and accepting user input to assign functions from the list of functions to the key layout, assignments of functions to the key layout being downloadable from the computer to the remote control to thereby configure the remote control to command operations of the specified type of the consumer electronic device and the specified brand of consumer electronic device.

63. The method as recited in claim 62, comprising displaying an amount of memory needed in the remote control to download from the computer to the remote control assignments of functions to the key layout.

64. The method as recited in claim 62, comprising presenting a graphical user interface having drag and drop capabilities for use in assigning functions from the list of functions to the key layout.

65. The method as recited in claim 62, comprising downloading from the computer to the remote control via a speaker assignments of function codes to the key layout.

66. The method as recited in claim 62, comprising downloading from the computer to the remote control a user interface having keys appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device, the user interface corresponding to the key layout.

67. The method as recited in claim 62, comprising downloading from the computer to the remote control via a memory card assignments of functions to the key layout.

68. The method as recited in claim 62, wherein the key layout comprises keys displayable in a display of the remote control.

69. The method as recited in claim 62, comprising directly downloading from the computer to the remote control assignments of functions to the key layout.

70. The method as recited in claim 54, wherein the plurality of command sets each comprise codes for driving an IR emitting diode of the remote control.

71. A method for selecting a command set for use in a remote control, comprising:

displaying at a Web site a list comprising a plurality of types of consumer electronic device for allowing a user to select one of the plurality of types of consumer electronic device from the list to specify a type of a consumer electronic device;

displaying at the Web site a list comprising a plurality of brands of consumer electronic device for allowing the user to select one of the plurality of brands of consumer electronic from the list to specify a brand of the consumer electronic device;

using the user specified type of the consumer electronic device and the consumer specified brand of the consumer electronic device to select a plurality of command sets that have been identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device;

making at least a subset of each of the plurality of selected command sets available whereby a user may determine by experimentation which one of the plurality of command sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device; and

displaying to the user at the Web site a key layout for the remote control and a list of

functions from the command sets determined to be appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device and accepting user input to assign functions from the list of functions to the key layout;

wherein the plurality of command sets and the assignments of functions to the key layout are downloadable from the Web site to the remote control to thereby configure the remote control to command operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.

72. The method as recited in claim 71, comprising arranging the plurality of command sets such that the plurality of command sets will be tested in an order according to their install base when the user determines by experimentation which one of the plurality of command sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.

73. The method as recited in claim 71, comprising displaying an amount of memory needed in the remote control to download from the Web site to the remote control assignments of functions to the key layout.

74. The method as recited in claim 71, comprising presenting a graphical user interface having drag and drop capabilities for use in assigning functions from the list of functions to the key layout.

75. The method as recited in claim 71, comprising downloading from Web site to the remote control via a speaker assignments of function codes to the key layout.

76. The method as recited in claim 71, comprising downloading from the Web site to the remote control a user interface having keys appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device, the user interface corresponding to the key layout.

77. The method as recited in claim 71, comprising downloading from the Web site to the remote control via a memory card assignments of functions to the key layout.

78. The method as recited in claim 71, wherein the key layout comprises keys displayable in a display of the remote control.

79. The method as recited in claim 71, comprising directly downloading from the Web site to the remote control assignments of functions to the key layout.

80. The method as recited in claim 71, wherein the plurality of command sets each comprise codes for driving an IR emitting diode of the remote control.

IX. Evidence Appendix

No copies of any evidence is being submitted herewith.

X. Related Proceedings Appendix

No copies of any decisions are being submitted herewith.

CHI 56551949v1